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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,833	12/27/2001	J. Jenny Yuan	ETH-1616	9040

27614 7590 10/04/2004

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EXAMINER


COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/032,833	YUAN ET AL. 	
	Examiner	Art Unit	
	David Comstock	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/02, 04/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Coleman (5,354,299).

Coleman discloses a driver 10 and cannulated interference screw 100 and method of using the same (see, e.g., Figs 1 and 3 and claims 1-7). The tool has a screw engaging portion 40 and a threaded tip 50 (see, e.g., Figs. 2, 3 and 5). The tool engages the screw in a hexagonal interface. The threaded tip extends past the end of the screw (see Fig. 9 and col. 4, lines 14-25). Any of the threaded tips can be considered as having "self-threading" features since the threads thereon are capable of threading themselves into material, for example, as the user pushes and rotates the screw with the tool to install the screw. The tips taper to a point in a direction distal of the screw. The threads at the very tip of the tool have the same general direction and pitch as the remainder of the threads on the tool. The tool has an abutment surface 34 proximate the screw engaging portion distal to the threaded tip (see col. 4, lines 14-16). The abutment surface 34 comprises at least radial components that extend perpendicularly to the screw engaging portion since the abutment surface is of a larger

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diameter than the screw engaging portion and limits the axial travel of the screw in a direction distal to the tip. The claimed tool is capable of receiving an appropriately sized screw in a friction fit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-14, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman (5,354,299).

Coleman discloses the claimed invention except for the screw being formed of a non-metallic, bioabsorbable material (e.g. tricalcium phosphate and polylactic acid matrix). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the screw from a non-metallic, bioabsorbable material (e.g. tricalcium phosphate and polylactic acid) or of any of numerous other known materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman (5,354,299) in view of Yamada (5,688,285).

Coleman discloses the claimed invention except for explicitly mentioning the interference fit between the tool and the screw. Yamada discloses a similar system

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having an interference fit, i.e. a snug fit, between the tool 34 and the screw hole 40 to better retain the screw thereon and improve the operation of the device (see Fig. 7; col. 5, lines 59-61; and col. 8, lines 23-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the driver and screw of Coleman with an interference fit, in view of Yamada, in order to better retain the screw thereon and improve the operation of the device.

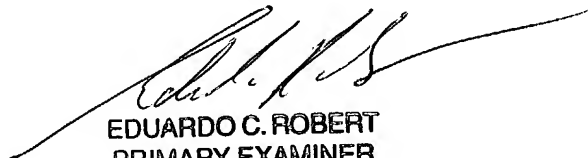
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock
29 September 2004



EDUARDO C. ROBERT
PRIMARY EXAMINER